

REMARKS

In view of the Office Action mailed 6/11/09, Applicant respectfully traverses the rejections as follows:

THE SECTION 112/132(a) OBJECTION

Applicant has removed the “without operator intervention” language and in lieu thereof has amended claim 1 to recite language from page 11 of the instant specification. Entry of the amendment is requested. Applicant has also clarified the claims in response to the requests in the Office Action.

THE SECTION 102 REJECTIONS

Claims 22-24 were rejected under Section 102(b) as anticipated by PAIR.

Applicant has clarified the claims and respectfully traverses the rejection.

Claim 22 recites automatically retrieving or generating copies of all patents and published patent applications based only on the assignee names. Claim 23 similarly recites an automatic method to download IP documents for a plurality of files by automatically determining published patent application numbers corresponding to the serial number for each file and then automatically download the documents for each such file. This is done automatically by the computer programmed in accordance with the invention without manual operator intervention - PAIR requires the user to inspect and manually enter each case and then click check boxes to select document(s) to download.

The systems of claim 22-23 programmatically automates this task for the user so that he/she can retrieve information on specified cases without having to click on buttons in each case to download. This enables seamless checking of the user's cases and can be done automatically without the user even being present. Hence, the system as claimed differs from PAIR, which is intended for manual human operation.

Claims 19-20 were rejected as anticipated by Grainger (20020161733) which shows:

[0096] Another function presented to the inventor is internal and external searching through various databases 150 including technical reference and patent databases. IP data management system 150 allows client systems to search through databases 150 using a common search engine and single search interface. This greatly simplifies the search process so that client systems are not required to learn different search engines for each different database that is searched. Additionally, system 150 allows a client system to define a search and then select which databases are to be searched. The selection mechanism allows for all databases to be searched, just patent databases, just technical journal databases and almost any other combination.

[0097] If the search function is executed during creation of an Invention Disclosure or after an Invention Disclosure has already been submitted, the process allows the client system to associate results from the searches with the reference number for the Invention Disclosure. When references are associated in this manner for a case that already has been submitted to a patent practitioner for preparation (or a case in which a patent application has already been prepared and filed), a message alert is automatically created and sent to the appropriate practitioner client system. This enables the practitioner client system to either review the references prior to or during preparation of the patent application or, if an application has already been submitted, review the references to decide whether an Information Disclosure Statement should be prepared and filed for the case. One way of allowing an inventor client system to associate references with a particular Invention Disclosure is to save the search results as a file, upload the file and associate the file with the Invention Disclosure.

However, Grainger relates to searching for prior art for IDS submission and not about freedom to operate search and about the minimum number of patents to allow the freedom to operate.

Page 3 of the Final Office Action noted that the Section 102 rejection of claims 19-20 as “Applicant fails to define what ‘freedom to operate’ is.”

Applicant requests reconsideration of the rejection. Freedom to operate is a common term. As noted at ip.com at <http://www.ip.com/patent-search-services/freedom-to-operate.jsp> : “Freedom to operate searches identify potential patent barriers to the commercialization of products or technologies. A freedom to operate search involves searching the claims language of third-party in-force patents to determine if the claims of the any prior art read on aspects of the technology that is to enter the

marketplace. Freedom to Operate research is typically conducted as a due diligence effort to prevent potential infringement.”

Here, Grainger relates to prior art submission rather than freedom to operate and thus cannot anticipate claims 19-20.

THE SECTION 103 REJECTIONS

Claims 1-6, 8-9 and 17 were rejected under Section 103(a) over Lundberg (7142713) and PAIR. Lundberg shows “scanning the form having written information thereon, the written information comprising a date and indicia defining a docket event, to obtain a scanned image. The indicia on the form defining a docketing event includes a title such as, “Office Action,” “Notice of Allowance,” “Notice of Missing Parts” and so forth. The date on the form includes, in many embodiments, “Date Mailed.” The method also includes processing the scanned image with character recognition logic and identifying the indicia defining the docket event or action and the date on the image.”

However, Lundberg does not show claim 1 with a computer implemented method for providing an electronic file wrapper information for IP applications by:

- authenticating a user with a patent office computer;
- for each file, under programmatic control:
 - determining an application identifier for the file;
 - searching the patent office computer and determining new docket item(s) not present in a local database;
 - downloading one or more documents associated with the new docket item(s) to the local database; and
 - automatically adding a docket entry with a deadline for each new docket item.

Lundberg operates by having humans scan office actions and then the information is converted through optical character recognition (OCR) and then docketing rules can be applied. In contrast, the present system receives the file wrapper information from the patent office computer and that information is used with the docketing rules. The system can operate in real-time whereas Lundberg requires human scanning. PAIR also fails to

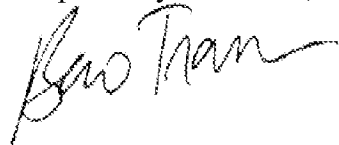
provide generating a docket entry with a deadline and a single electronic document for an entry in the electronic file wrapper information, the document having all images for the entry consolidated therein without operator intervention. As discussed above, in PAIR, the user manually selects files and manually download files to a local computer. There is no automated facility so that many files can be handled without operator intervention. Combining PAIR with Lundberg would not result in an operative system since the information in Lundberg is received through normal mail channel and cannot operate in real time. Further, the combination would still require human interaction to receive information on each case and thus would be difficult to use since an operator has to manually specify and retrieve each file using PAIR and Lundberg. In addition, PAIR points away from a combination with Lundberg since the information in PAIR needs not be scanned.

In sum, the claims overcome PAIR, Lundberg and Grainger. Withdrawal of the rejection is respectfully requested.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bao Tran", with a stylized flourish at the end.

Bao Tran
Reg. No. 37,955